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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/384,379      | 08/27/1999  | YOSUKE AOKI          | 2167-0110P          | 7722             |

2292 7590 11/26/2003

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EXAMINER

NGUYEN, BAO THUY L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1641

DATE MAILED: 11/26/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/384,379

Applicant(s)

AOKI ET AL

Examiner

Bao-Thuy L. Nguyen

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

1. Applicant's amendment filed 9/26/03 has been received. Claims 5-9 are pending.
2. All rejections not reiterated herein below are withdrawn in view of the amendment to the claims.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to provide an adequate written description of the invention and fails to provide an enabling disclosure, because the specification does not provide evidence that the claimed biological materials are: (1) known and readily available to the public; (2) reproducible from the written description; or, (3) deposited in compliance with the criteria set forth in 37 CFR "1.801-1.809."

The specification lacks complete deposit information for the monoclonal antibodies recited in claim 5. Because it is not clear that the monoclonal antibodies designated 3F03, 3G03, 2E04 and 1G12 are known and publicly available or can be reproducibly isolated without undue experimentation, and because the invention of claims 5-9 claims or uses these monoclonal antibodies, a suitable deposit for patent purposes is required. Accordingly, filing of evidence of the reproducible production of the cell lines and antibodies necessary to practice the instant invention or filing of evidence of deposit is required. Without a publicly available deposit of the above cell lines, one of ordinary skill in the art could not be assured of the ability to practice the invention as claimed. Exact replication of the cell lines is an unpredictable event. Applicants must comply with the criteria set forth in 37 CFR §§ 1.801-1.809.

If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicant, or a statement by an attorney of record over his or her signature and registration number, stating that the specific cell lines have been deposited under the Budapest Treaty, that the cell lines will be irrevocably and without restriction or condition released to the public upon the issuance of a patent and that the cell lines will be replaced should they ever become non-viable, would satisfy the deposit requirement made herein.

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If the deposits have not been made under the Budapest Treaty, then in order to certify that the deposits meet the criteria set forth in 37 CFR §§ 1.801-1.809, applicant may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that:

1. during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
2. all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
3. the deposits will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;
4. the deposits were viable at the time of deposit; and,
5. that the deposits will be replaced if they should ever become non-viable.

In the instant case, no deposit information has been provided either in the specification or in the form of an affidavit or declaration; nor is there available a viability statement, i.e. one certifying that the deposit was viable at the time of the deposit or a certificate verifying such from the depository.

As a possible means for completing the record, applicant may submit a copy of the contract with the depository for deposit and maintenance of each deposit along with the necessary statements in order to meet the criteria set forth in 37 CFR §§ 1.801-1.809.

Applicant's attention is directed to *In re Lundak*, 773 F.2d. 1216, 227 USPQ 90 (CAFC 1985) and 37 CFR §§1.801-1.809 for further information concerning deposit practice.

#### *Allowable Subject Matter*

5. Claims 5-9 are free of the prior art.
6. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record differs from the instant invention in failing to teach an immunoassay to detect human medullasin using monoclonal antibody selected from the group consisting of monoclonal antibody 3F03, 3G03, 2E04 and 1G12.

#### *Conclusion*

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao-Thuy L. Nguyen whose telephone number is (703) 308-4243. The examiner can normally be reached on Tuesday and Thursday from 9:00 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 and (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Bao-Thuy Nguyen  
Primary Examiner  
20-Nov-03